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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,567	10/18/2000	Yoshihiko Hibino	001248	8750
7590 04/23/2004			EXAMINER	
Armstrong Westerman Hattori McLeland & Naughton 1725 K Street NW Suite 1000 Washington, DC 20006			SCHWARTZ, PAMELA R	
			ART UNIT	PAPER NUMBER
			1774	
DATE MAILED: 04/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/673,567	Applicant(s) HIBINO ET AL.	
	Examiner Pamela R. Schwartz	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s): _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>12</u> . | 6) <input type="checkbox"/> Other: |

Art Unit: 1774

1. Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification does not enable one of ordinary skill in the art to make the invention when it requires the presence of a "polyvinyl alcohol-cation monomer graft polymer." The only examples of what is meant by the term appear to be references to foreign trade-named materials. No specific example of monomers has been set forth. There is not sufficient evidence of record setting forth the formulation of the polymer relied upon herein. Without information concerning the formulation, applicants' cannot assert that one of ordinary skill in the art will be able to practice the invention from their disclosure, because formulations of trade-named materials can be changed and applicants have not provided any independent opportunity for reformulating or recreating this material so critical to their invention.

Applicant's Declaration has been fully considered but is not persuasive.

Applicant's Declaration states that the trade-named material was available for purchase but provides no evidence of its formulation. The company may change the formulation or the company may decide to no longer produce and sell the material. Therefore, evidence of the formulation of the trade-named material at the time of the invention, such as information set forth in sales brochures or product bulletins, including sufficient detail about the materials involved, must be submitted in order to overcome this rejection.

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2. Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koide et al. (5,756,151) in view of Yasuda et al. (4,944,988) and Koji et al. (EP 0745,488) for reasons of record and for reasons given below. Applicants' amendments to the claims, move the language of claim 3 into the independent claim and change the phrase "containing a water soluble binder..... " to "containing a binder consisting essentially of a water-soluble binder....". Because of the open claim language "containing", the use of the article "a" which would ordinarily mean that other binders can also be present, and the absence of language explicitly limiting the claim to the presence of only one binder, the added phrase "consisting essentially of" is not considered to further limit the claim. Even if it did further limit the claim, it is not closed language and not equivalent to the use of "consisting of" language. At this location in the claim, even the use of "consisting of" would fail to exclude the presence of other binders.

3. Applicants' arguments filed January 26, 2004 have been fully considered but they are not persuasive. Contrary to applicants' arguments claim 1 does not identify "the binder", but rather "a binder" as consisting essentially of a water-soluble polymer. This difference renders the "consisting essentially of" language non-limiting.

Applicants' arguments with respect to Yasuda et al. are confusing. They refer to reliance on col. 9, lines 36-40 by the Examiner, but the Examiner did not rely on this section in the last office action. In the last office action, the Examiner did rely on disclosures in col. 7 and 8, and maintains her position that there is motivation for

including an additional resinous binder material to increase mechanical strength as taught by Yasuda et al.

Additionally, the basis for applicants' statement that "one of ordinary skill in the art would not be motivated to use such a substance according to the patent with a water-soluble binder" has not been set forth. Applicants' argument appears to be directed to the disclosure in column 9 as opposed to the passages in columns 7 and 8 that were actually relied upon in the rejection.

Contrary to applicants' statement that in the instant claims "the binder consists of a water-soluble binder" the actual claim language is still entirely open for the reasons set forth above. Even if the phrase "consisting essentially of" did act to limit the claim, it would not preclude the presence of a water soluble binder that did not affect the basic and novel characteristics of the invention. The examiner does not believe that the presence of a water soluble binder in applicants' coating would do so since the resulting material would still be an ink jet recording paper with a high degree of brightness as instantly claimed.

Applicants' earlier filed Declaration under 37 CFR 1.132 is unpersuasive for reasons given in the final rejection of May 20, 2003.

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

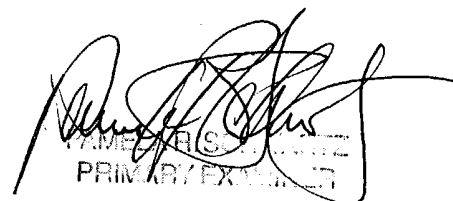
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Schwartz whose telephone number is (571) 272-1528.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on (571) 272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRSchwartz
April 6, 2004



Handwritten signature of Pamela Schwartz over a rectangular stamp. The stamp contains the text "PAMELA SCHWARTZ" and "PRIMARY EXAMINER" in a grid-like format.